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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,502

12/10/2004

Hidekuni Murakami

52433/781

1252

26646 7590 10/11/2007
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EXAMINER

YEE, DEBORAH

ART UNIT

PAPER NUMBER

1793

NOTIFICATION DATE

DELIVERY MODE

10/11/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@kenyon.com

Office Action Summary

Application No.

10/517,502

Applicant(s)

MURAKAMI ET AL.

Examiner

Deborah Yee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of group I, claims 1 to 6 in the reply filed on July 27, 2007 is acknowledged. The traversal is on the ground(s) that the present application is a 35 U.S.C. 371 national stage of PCT/JP03/02672, therefore PCT unity of invention rules apply. Claims 1 to 6 are directed to a steel sheet. Claims 7 to 8 are directed to a method for manufacturing the steel sheet. See 37C.F.R. 1.475(b)(1). This is not found persuasive because of the reasons stated in the previous Restriction. Note the the inventions listed as Groups II and I do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The common technique feature that groups II share and I is the composition of claim 1. This composition does not provide a contribution over the prior art as evident by Japanese patent 2002-80934. Thus the 2 groups lack unity of invention, see MPEP 1850.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1 to 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the computer generated English translation of Japanese patent 2002-80934 (hereinafter JP'934) for the reasons set forth in the previous office action dated April 26, 2007

Response to Arguments

4. Applicant's arguments filed July 27, 2007 have been fully considered but they are not persuasive. It was submitted that the technology disclosed in JP'934 discloses a steel sheet similar to the steel compositions according to the present invention. However, JP'034 does not disclose or suggest the combination of the nitride diameters and nitride distributions.

5. It is the examiner's position that JP'034 does closely suggest the combination of the nitride diameters and nitride distribution recited by the present invention. As stated in the previous office action, claim 3 of JP'934 recites the average diameter of precipitates of BN alone or BN-containing composite precipitates have a diameter of not less than 0.005 μm to not more than 0.50 μm , and not more than 10% of the number of said precipitates having a diameter of not less than 0.005 μm to not more than 0.50 μm being accounted for by precipitates having a diameter of not more than 0.01 μm . Note that prior art nitride limitation overlaps with "simple or compound nitrides having a diameter of 0.02 to 0.50 μm which contain B or Al, and having the average diameter of 0.08 μm or larger, and the proportion of the number of the nitrides of 0.050 μm or smaller in diameter to the total number of said nitrides being less than 10%" recited by applicants' claims 1 to 4; and such overlap in nitride ranges establishes a prima facie case of obviousness because it would be obvious for one skilled in the art to select the

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claimed ranges over the broader disclosure of the prior art since the prior art teaches the same utility and properties.

6. Moreover claim 1 of JP'934 recites (the amount of N existing as BN)/ (the amount of N existing as AlN) is ≥ 10 which meets applicants' claim 5 limitation; and claim 2 of JP'934 recites (the amount of N existing as BN)/ (the N content) ≥ 0.8 which meets applicants' claim 6 limitation.

7. Applicants argued that JP'934 steel sheet is made by a different process than present invention and therefore the diameters of the simple or compound nitrides and nitride distributions are different. It is the examiner's that prior art steel sheet meets the composition, overlaps and closely meets the nitride diameter and nitride distribution range, and also satisfies the BN ratios. Even though the prior art product is made by a different process, such would not be a patentable distinction. Note that in a product claim, determination of patentability is based on the product itself. Applicants will have the burden to show that the prior art product does not necessarily or inherently possess the characteristics of the claimed product.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on monday-friday 6:00am-2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deborah Yee/
Primary Examiner
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DY